In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 482

VINCENT W. ECKEL, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

MEMORANDUM FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

This action was brought by petitioner under 35 U.S.C. 145 to obtain review in the district court of the denial by the Patent Office of his application for a patent relating to alleged improvements in a solenoid-operated actuator and valve. The alleged improvements consist of a housing "made of magnetizable material" and "a sleeve of non-magnetizable material disposed between the adjacent ends of the opposing

pole portions" (Pet. App. 6).[1] Both the Patent Office Examiner (J.A. 183-184, 187-188, 209-210) and the Patent Office Board of Appeals (J.A. 229-235) held petitioner's claims unpatentable on the ground that in view of the prior art—especially the Fuscaldo and Gachon patents—the substance of the claims "would be obvious to a person having ordinary skill in the art, the person being anyone of average engineering knowledge" (J.A. 234).[2]

As the district court noted, "[i]t was generally admitted [by petitioner] at trial that the components of the Gachon device and the manner in which they were assembled was highly similar to the subject matter plaintiff claimed as his invention. The plaintiff's principal effort was to establish that his device was constructed of different *materials* than that of Gachon." (Pet. App. 8; emphasis in original.) After careful examination of the patent application and comparison with the Gachon device, the court found that, although the Gachon patent did not expressly state what materials its casing or the annular T-shaped sleeve was made of (Pet. App. 8), the Gachon device was "operable with a magnetizable casing"

---

[1] "Pet. App." refers to the appendix to the petition for a writ of certiorari. "J.A." refers to the Joint Appendix in the court of appeals, 10 copies of which have been filed with this Court by petitioner.

[2] "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. 103.

and "Gachon's sleeve of T-shaped cross-section was made of non-magnetizable material" (Pet. App. 9). Accordingly the court held (Pet. App. 9-10):

> With the above interpretation of the Gachon patent, it appears to the Court that the plaintiff's structure is completely disclosed. Manifestly, the Court cannot say that plaintiff's subject matter would have been unobvious in view of Gachon and Fuscaldo to a person skilled in the art to which all of these disclosures pertain.

The court similarly rejected petitioner's contention "that his device satisfied a long-felt want in the aircraft and space industry for lightweight valves," finding that the evidence on this point was not "sufficient to overcome what it [the court] considers to be a clear disclosure of the claimed subject matter by the prior art" (Pet. App. 10).[3]

The court of appeals affirmed in a *per curiam* opinion, stating that it was "in general agreement with the opinion filed herein by the District Court" (Pet. App. 4).

This case presents purely factual issues, raised by the application of undisputed legal principles to a

---

[3] This was in accord with this Court's repeated observation that the fact that a "process has filled a long felt want and has been a commercial success" is "relevant only in a close case where all other proof leaves the question of invention in doubt." *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 330. See, also, *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 153; *Toledo Pressed Steel Co.* v. *Standard Parts, Inc.*, 307 U.S. 350, 356-357.

particular patent claim. There is accordingly no occasion for further review by this Court.

Petitioner's contention that the district court ruled that a patent must be denied unless it can be said that the invention was "unobvious", thereby applying an erroneous legal standard, is based on a misreading of this language in its context. The court expressly stated that "it appears to the Court that the plaintiff's structure is completely disclosed" by the prior art (Pet. App. 9), and expressly concluded that the additional evidence of commercial need did not "overcome what it considers to be a clear disclosure of the claimed subject matter by the prior art" (Pet. App. 10). Thus, the court applied the proper test.[4]

Moreover, there exists a presumption of the validity of the Patent Office decision. In *Morgan* v. *Daniels*, 153 U.S. 120, this Court held that the decision of the Patent Office must be accepted as controlling "unless the contrary is established by testimony which in character and amount carries thorough conviction." 153 U.S. at 125. This holding, which has been consistently applied (see *e.g.*, *Gold* v. *Newton*, 254 Fed. 824, 827-828 (C.A. 2), certiorari denied, 249 U.S. 608; *Abbott* v. *Coe*, 109 F. 2d 449, 451-452 (C.A. D.C.); *Zenith Radio Corp.* v. *Ladd*, 310 F. 2d 859, 862 (C.A. D.C.)), supports the decision below.

---

[4] Petitioner so recognized, in stating in his Statement of Points to the Court of Appeals that the District Court erred "[i]n holding that the invention set forth in Plaintiff's claims 1 to 16, and each of them, is obvious to a person of ordinary skill in the art and therefore lacking in patentable novelty under the Patent Statutes" (see paragraph 23, at J.A. 37).

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

THURGOOD MARSHALL,
Solicitor General.

JOHN W. DOUGLAS,
Assistant Attorney General.

SHERMAN L. COHN,
JACK H. WEINER,
Attorneys.

SEPTEMBER 1965.

☆ U. S. GOVERNMENT PRINTING OFFICE: 1965 787270 194